



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,286	06/21/2001	Naofumi Hirayama	041514-5122	2660

9629 7590 12/17/2004

MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER
----------

UBILES, MARIE C

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/885,286	HIRAYAMA ET AL.	
	Examiner	Art Unit	
	Marie C. Ubiles	2642	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/17/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Kosaka (US 6,687,515).

As for claim 1, Kosaka discloses a portable telephone (or *portable video phone 14*, See Fig. 1) comprising a display part which can display a moving image (or *display 8*, See Fig. 1); an image signal receiving part which receives an image signal sent over a mobile communication network (or *wireless transceiver 2*, See Fig. 2)(See Col.3, lines 21-24); an image signal reproducing part which reproduces said image signal which has been received by said image signal receiving part and makes said display part display a reproduced image (or *image processor 7*, See Fig. 2)(See Col. 3, lines 36-40); and a

Art Unit: 2642

permission signal sending part for sending a permission signal to permit an image-pickup part to output image signal to said image-pickup part to be connected via the mobile communication network (may be read on the received base signal process band performed after the IMAGE key is pressed for transmission and receipt of voice and data)(See, Col. 2, line 63 through Col. 3, line 30).

As for claim 2, Kosaka discloses the system as claimed further comprising a decompressing part for decompressing a compressed digital image signal which has been received by said image signal receiving part (See Col. 3, lines 35-40).

Claim 6 is rejected for the same reasons as claim 1, the "sending/receiving part" limitation may be read on the functions performed by the "wireless transceiver 2" (See Fig. 2). The "image pick-up part" limitation may be read on Kosaka's disclosure of caller being able to receive an image and this image being displayed on "display 8".

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

Art Unit: 2642

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 3-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosaka (US 6,687,515).

Regarding claims 3, Kosaka discloses the system as claimed in claim 1, except for “a monitoring camera device which is connected to said portable telephone via a mobile communication network and sends an image signal obtained by imaging” and “an image pickup part which is installed and oriented toward a desirable object to be monitored and an image signal sending permission part which detects the permission signal sending part of the portable telephone via the communication network and permits sending of an image signal from said image-pickup part to said portable phone”.

However, while not taught directly by Kosaka, it would have been obvious to one of ordinary skill in the art that Kosaka's system is capable of performing the aforementioned functions. For example, if two of the portable video phones, as taught by Kosaka, are communicating with each other, then it will be possible to monitor or observe a “desirable object” from the called end side and deliver that image to the image pick-up part of the calling side portable phone. As explained above, the “permission signal” may be read on the functions performed after the “IMAGE” key is pressed during call set-up.

As for claims 4-5, the limitations are read on the functions performed by Kosaka's system as described in Col. 3, lines 1-7 and lines 36-40.

Claims 8-9 are rejected for the same reasons as claim 3. The "sending/receiving part" limitation may be read on the functions performed by the "wireless transceiver 2" (See Fig. 2). Regarding the limitation specifying "imaging a view of a surrounding area...", "making the image of the view of the surrounding are...", and "...is a view of a surrounding area of a place of a meeting"; may be read, for example, on the called side end user taking the portable video phone on his/her hand a capturing on the camera the surrounding area.

As for claim 7, the limitation specifying the use of a "CCD camera" may be read on the functions performed by "camera 9" (See Col. 4, lines 58-61).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Allport (US 6,097,441) teaches a system for dual display interaction in which a base station and a remote control communicate via RF.

Ida et al. (US 5,191,601) teaches a videophone unit.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.

Art Unit: 2642

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marie C. Ubiles  
December 2, 2004.



AHMAD MATAR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600